



AF/3679

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): **Russell D. Cole**
Serial No.: **09/656,013**
Filed: **09/07/2000**
Title: **Magnet Picture Pal**

Appeal No.: **Unknown**
Group: **3679**
Examiner: **James M. Hewitt**
Date:
Docket No.: **SP 1042**

APPEAL BRIEF TRANSMITTAL FORM

Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the appellant(s) in connection with the above identified application.

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Respectfully submitted,
Patent & Trademark Services, Inc.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Russell D. Cole

Appeal No.: Unknown

Serial No.: 09/656,013

Group: 3679

Filed: September 7, 2000

Examiner: James M. Hewitt

Title: Magnet Picture Pals

Docket No. : SP 1042

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GROUP 3679

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APPELLANT'S BRIEF

Serial No. 09/656,013



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Filed: September 7, 2000

Examiner: James M. Hewitt

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APPELLANT'S BRIEF

Honorable Commissioner of Patents and Trademarks

Washington, DC 20231

Sir:

Enclosed is an appeal from the final rejection dated September 11, 2002 finally rejecting claims 7- 10. No claims have been canceled.

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REAL PARTY IN INTEREST

The party identified in the caption of the brief is the real party in interest.

RELATED APPEALS OR INTERFERENCES

There are no appeals or interferences known to appellant, or the appellant's legal representative (there is no assignee) which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF THE CLAIMS

Claims 7- 10 remain in the application and is rejected. No claims are allowed.

STATUS OF THE AMENDMENTS

An amendment have been presented after Final Rejection to correct the 35 USC 112, second paragraph, rejection of claims 7- 9 and the objection to claim 7.

SUMMARY OF THE INVENTION

The invention relates to the combination of holder and an object with corner edges. The holder (page 4, line 13 of spec. and Figures 1- 2) has a three distinct layers. The holder has a corner pocket 7 used to engage a corner edge

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of the object 13 to be held (page 5, lines 1- 6 of spec. and Figures 1- 2). The first layer 3 has a non-slip material that engages and bear against a corner surface of the object to be held (page 4, lines 14 -17 of spec. and Figure 2). The second layer 5 has magnetic material (page 4, last line and page 5, line 1 of spec. and Figures 1 and 2) . The third layer 7 is a transparent material shaped to form the pocket corner pocket (page 5, lines 1- 6 of spec. and Figures 1- 2). The object 13 has corner edges to complement the size and shape of the corner pocket formed by layer 7. (page 6, lines 10- 11 of of spec. and Figure 2). (claim 7).

The holder may consist of two identical holders 1 (page 7, lines 1-4 and lines 13- 14 of spec. and Figure 3 (a)).(claim 8) . The holder by itself has the three layers 3,5 and 7 with a corner pocket for the corner edge of an object to be held. (page 4, lines 12- 14, Figures 2 and 3(a)). A supporting surface 11 for the holder (page 6, lines 12- 17 , Figure 3(a)) and there is a first layer 3 with a non-slip surface that engages and bear against a surface of the object to be held (page 4, lines 14- 17 of spec. and Figure 2). A second layer 5 has magnetic material (page 4, last line and page 5, line 1 of spec. and FIG. 2). A third layer 7 has a transparent material which forms with the first layer 3 and object receiving pocket between the third layer and the first layer (page 5, lines 12 -16 of spec. and FIG. 1). The second layer 5 may be directly against and held to the

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supporting surface 11 by the magnetic material. (page 6, last two lines of spec.) (claim 9). The second layer 5 may be fixed to the first layer 3 (page 4, last to be lines of spec. and FIG. 2). (claim 10).

ISSUES ON APPEAL

The issues in this appeal are whether claims 7- 10 are rejectable under 35 USC 103(a) as being unpatentable over the Engel reference in view of the Good reference.

GROUPING OF CLAIMS

Claims 7- 8 stand or fall together with the independent claim 7 and claim 9 and 10 stand or fall together with independent claim 9.

ARGUMENTS

For the purposes of this appeal, the claims in the appendix are the same claims presented in the Amendment filed after Final Rejection. There is no

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material difference between the subject matter claimed in these claims and the claims rejected by the Examiner in the final rejection. The purpose for filing the Amendment after final rejection was to be avoid the objects and rejections based on informalities in claim language.

In the Engel reference (2,068,909) cited and applied in the final rejection, discloses a transparent mounting corner. In Figures 5 and 6 modification the three-ply lower wall of the corner projects beyond the transparent wall 20 (page 2, col. 1, lines 40 et seq.). An adhesive material is used to mount the holder to a supporting surface is on the under side of the member 1. (page 1, column 2, lines 53 -55). Apparently this adhesive material is labeled 10 in the Figures 5 -6 modification. The flaps 4 of the transparent member 2 are secured to the upper gummed surface of member and the third gummed member 3 is inserted in the pocket so that its gummed surface is adhesively secured to the upper or inner surfaces of the flaps 4. (page 1, col. 2, lines 23 et seq.). Using adhesives provides for a secure and most likely permanent attachment of the holder to the supporting surface.

In the Good reference magnets are used to hold a frame 10 to a supporting surface. (col. 2, lines 14 et seq.). Applicant uses magnets to allow for the easy attachment of the corner holder to a supporting surface having the necessary magnetic attraction properties and to also permit the easy removal when another

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object is to be held. In Good the magnets simply hold a frame to a supporting surface having magnetic attraction properties. There simply is no suggestion that these magnets can be used in corner pocket for the corner edge of an object to be held.

The Board's attention is directed to the recent (2002) Court of Appeals for the Federal Circuit (CAFC) case of In re Lee (61 USPQ 2nd 1431). Therein on page 1433 the Court stated "This factual inquiry to combine references must be thorough and searching. It must be base on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with...a showing or a suggestion, teaching or motivation to combine the prior art references is an essential component of an obvious holding..." Here the Examiner provides no such analysis or evidence of record to combine the references of record to meet the claim language.

Having magnets used to hold a frame to a supporting surface is not the same as using magnets or magnetic material in a corner pocket that engages the corner edge of the object to be held. Neither the Engel or the Good reference suggest, teach or otherwise motivate a person to change the adhesive material of Engel to a magnetic material.

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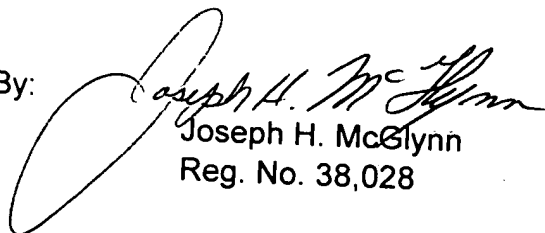
CONCLUSION

Appellant respectfully submits that the references relied upon by the Examiner fails to suggest or teach the configuration of the claimed invention, and that the rejection relying upon the art of record is improperly founded both in fact and in law. Therefore, the examiner's rejections should be reversed and a decision rendered favorable to the appellant.

Accordingly, the Honorable Board of Patent Appeals and Interferences is respectfully requested to reverse the examiner's rejection of claims 7 - 10 under 35 USC 103 and to render a decision favorable to appellant.

Respectfully submitted,
Patent & Trademark Services, Inc.

By:


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APPENDIX

Claim 7. The combination of a holder and an object with corner edges comprising:
a holder having at least three distinct material layers,
said holder comprising a corner pocket to engage a corner edge of the object
to be held,
the first layer of said at least three distinct layers having a non-slip surface to
engage and bear against a corner surface of the object to be held,
the second layer of said at least three distinct layers having magnetic material,
the third of said at least three distinct layers consisting of a transparent
material to shaped to form the corner pocket; and
an object having corner edges to complement the size and shape of the corner
pocket formed.

Claim 8. The combination of a holder and an object with corner edges as claimed in
claim 7 wherein said combination comprises at least two substantially
identical holders,
said two substantially identical holders being spaced from each other and
adapted to receive a different corner of the object to be held.

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Claim 9. A holder for an object and a supporting surface for the holder

comprising:

a holder having three layers,

said holder comprising a corner pocket for the corner edge of the object to be held,

a supporting surface for the holder,

the first layer of said three layers having a non-slip surface to

engage and bear against a surface of the object to be held,

the second layer of said three layers having magnetic material,

the third layer of said three layers consisting of a transparent material layer to form with said first layer the object receiving pocket between the third layer and the first layer, and

said second layer being directly against and held to the supporting surface by the magnetic material.

Claim 10. The holder for an object and a supporting surface for the holder as

claimed in claim 9, wherein the second layer with magnetic material is

fixed to the first layer.